APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,779	04/12/2001	Martin Pellinat	254/266	3765

7590   03/15/2004

Troy M Schmelzer
PROCOPIO CORY HARGREAVES & SAVITCH LLP
530 B Street
Suite 2100
San Diego, CA 92101-4469

EXAMINER
HOLMES, MICHAEL B

ART UNIT	PAPER NUMBER
2121	

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/834,779	PELLINAT, MARTIN
	Examiner	Art Unit
	Michael B. Holmes	2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>(3)</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 February 2004</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) <u>1,2,6-11 and 14</u> is/are allowed.

6)☒ Claim(s) _____ is/are rejected.

7)☒ Claim(s) <u>3-5,12 and 13</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner's Detailed Office Action

1. This office action is responsive to application **09/834,779**, filed **April 12, 2001**.

2. **Claims 1-14** have been examined.

Information Disclosure Statement

3. Applicant is respectfully remind of the Duty to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, by continuing to submitting in a timely manner PTO-1449, Information Disclosure Statement (IDS) with the filing of applicant's of application or thereafter.

Drawings

5. The formal drawings have been reviewed by the United States Patent & Trademark Office of Draftperson's Patent Drawings Review. Form PTO-948 has been provided.

Specification

6.   The specification has not been checked to the extent necessary to determine the presence

of all possible minor errors. Applicant's cooperation is required in correcting any errors of which

applicant may become aware in the specification. Appropriate correction is required.

Claim Interpretation

7.   Office personnel are to give claims their **"broadest reasonable interpretation"** in light

of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28

(Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not

read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551(CCPA

1969). See *also In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322(Fed. Cir. 1989)

("During patent examination the pending claims must be interpreted as broadly as their terms

reasonably allow. . . . The reason is simply that during patent prosecution when claims can be

amended, ambiguities should be recognized, scope and breadth of language explored, and clari-

fication imposed. . . . An essential purpose of patent examination is to fashion claims that are

precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be

removed, as much as possible, during the administrative process."). *see* MPEP § 2106

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9.   **Claims 6, 9 & 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the scope of the claim language is represented as an improper Markush claim, and thus is vague and indefinite. i.e., it is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). MPEP 2173.05(h). Moreover, the word "comprising" does not exclude and as a result renders the claims vague and indefinite, because it is unclear if the scope of the claim is referring to selecting one or more, all, or even things outside of the group. Accordingly, Examiner will interpret it as one.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11.   The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

12.   **Claims 1-3, 6-10** are rejected under 35 U.S.C. 102(e) as being anticipated by

Richards et al. (UNPAP Pub. No. US 2002/0145626 A1), Filed Feb. 9, 2001;

Pub Date: Oct 10, 2002.

Regarding Claim 1:

Richards et al. teaches,

A computer-implemented system for personal development training comprising:

user input comprising the user's goal, possible outcomes and influence factors on the

possible outcomes; **[0031** (*"On accessing the web site, the user may locate the tool access button*

on the first web page and click on the button to download the first part of the tool. In this

embodiment, as the user completes registration information (such as, but not limited to,

personal details, professional qualifications, goals, objectives) downloads of necessary software

may be completed in parallel. In this embodiment, the user may be greeted by a 3-dimensional

graphic user interface and an animated "talking head" virtual coach who helps the user to input

information. User specific information may be supplied through user text entry, multiple

choice from drop-down menus, responses to audio clips and videos, user-positioning of objects

on the screen, and role-playing in on-screen animations.")] & **[0033** (*"The data acquisition*

phase may continue with the definition of the types of currency traded between the user and

network contacts. In this context, currency refers to characteristics of the relationship such as

the level of mutuality and reciprocity of the relationship, the predictability of the relationship,

the level of trust and the ability for each individual to express them- selves. Some of the

questions posed may be repeated within different phrasings to validate the responses. In one

embodiment, the data acquisition phase may allow users to complete specific network

connections in their entirety or allow desired network connections to be assessed according to a

specific question category, for example, trust or mutuality or predictability.")] a processor for

preprocessing the user input and generating an action plan based on the user input. **[0330 (***"An*

example system that would enable the software program to operate effectively would be a PC

with a high speed processor ....")[**&** **[0028 (***"Once these elements have been identified, they*

can be used to **construct a plan of action** *against which the user can re-position their working or*

personal objectives.")] **& [FIG. 20: Analysis Flowchart; Process box: "Action Plan defined**

by system")]

Regarding Claim 2:

Richards et al. teaches,

The system of claim 1 wherein the user input comprises:

one or more statements of vision and Goal; **[0031 (***"On accessing the web site, the user may*

locate the tool access button on the first web page and click on the button to download the first

part of the tool. In this embodiment, **as the user completes registration information (such as,**

but not limited to, personal details, professional qualifications, goals, objectives) *downloads of*

necessary software may be completed in parallel. In this embodiment, the user may be greeted by

a 3-dimensional graphic user interface and an animated "talking head" virtual coach who helps

*the user to input information. **User specific information may be supplied through user text***

entry, multiple choice from drop-down menus, responses to audio clips and videos, user-

***positioning of objects on the screen, and role-playing in on-screen animations.**")] & [0033*

*(**"The data acquisition phase may continue with the definition of the types of currency traded***

between the user and network contacts. In this context, currency refers to characteristics of

the relationship such as the level of mutuality and reciprocity of the relationship, the

predictability of the relationship, the level of trust and the ability for each individual to express

them- selves. Some of the questions posed may be repeated within different phrasings to

***validate the responses.** In one embodiment, the data acquisition phase may allow users to*

complete specific network connections in their entirety or allow desired network connections to

be assessed according to a specific question category, for example, trust or mutuality or

predictability.")]

one or more statements of possible outcomes; [(" ")]

influence factors for each of the possible outcomes; and

relevant data for each of the influence factors. [0031 (*"On accessing the web site, the user may*

locate the tool access button on the first web page and click on the button to download the first

*part of the tool. In this embodiment, **as the user completes registration information (such as,***

***but not limited to, personal details, professional qualifications, goals, objectives)** downloads of*

necessary software may be completed in parallel. In this embodiment, the user may be greeted by

a 3-dimensional graphic user interface and an animated "talking head" virtual coach who helps

*the user to input information. **User specific information may be supplied through user text***

entry, multiple choice from drop-down menus, responses to audio clips and videos, user-

***positioning of objects on the screen, and role-playing in on-screen animations.**")] & [0033*

*(**"The data acquisition phase may continue with the definition of the types of currency traded***

between the user and network contacts. In this context, currency refers to characteristics of

the relationship such as the level of mutuality and reciprocity of the relationship, the

predictability of the relationship, the level of trust and the ability for each individual to express

them- selves. Some of the questions posed may be repeated within different phrasings to

***validate the responses.** In one embodiment, the data acquisition phase may allow users to*

complete specific network connections in their entirety or allow desired network connections to

be assessed according to a specific question category, for example, trust or mutuality or

predictability.")]

Regarding Claim 3:

Richards et al. teaches,

The system of claim 2 wherein the relevant data for each of the influence factors comprises:

the effect of the influence factor on the possible outcome; **[0032** (" *[0032] In a particular*

embodiment, the user information specified in the registration process may be used to define a

central "NetSphere" that identifies the user. ***The user may then be instructed to locate other***

spheres around them, corresponding to the people who they associate with in order to do their

jobs. The people they work most frequently with may be placed closest to them. The formal

organizational structure may be reflected by placing contacts who are more senior above them

on the screen and more junior contacts may be placed below them. Customers who are

important contacts may be defined as such from a drop down menu and identified, for

example, by means of 3-D diamonds. Consideration of the relationships and networking

capabilities of a person to a customer would be very valuable to businesses that desire strong

customer relationship management. Suppliers may be equally identified, where desired, from

a drop down menu as, for example, 3-D cubes. Each contact within the network may then

connected to the user sphere by a line whose type denotes the importance of the relationship to

the user. The type, in this embodiment, may be double lines, single lines or dotted lines denoting

decreasing importance. ")]

the weight of the influence factor on the possible outcome;

a statement about what drives the influence factor;

the timeframe tinder which the influence factor operates;

an affecting influence statement about how to affect the influence factor;

the weight of affecting the influence factor;

the risk of affecting the influence factor; and

the willingness to take the risk.

Regarding Claim 6:

Richards et al. teaches,

The system of claim 1 wherein the system is implemented using at least one of a group

comprising software, a semiconductor device;

a graphical user interface; **[0030** (*"[0030] On beginning a downloaded software program or software loaded from source media such as a CD-ROM, DVD, Zip.TM. disc or floppy disc that executes a networking exercise on a system such as a computer (PC, Macintosh.TM., network PC or other machine capable of running and displaying applications software programs), a user completes a registration process in which personal details are entered and the user is then presented with a series of instructions and objects. The data relating to personal details and all other user-defined data are stored in software-defined data files, either on a hardware system's (PC, Macintosh.TM., network PC etc) hard drive or on a removable media drive (floppy disc, Zip.TM. disc, magnetic tape or re-writeable CD-ROM for example), the data destination being definable by the user. An example system that would enable the software program to operate effectively would be a PC with a high speed processor (for example 600 MHz Intel Pentium.TM. III with MMX technology and 512K cache), 13 Gb Ultra ATA hard drive (5400 rpm), 8.times. DVD-ROM, 256 Mb SDRAM, 32 Mb Diamond Viper V770D AGP Graphics Card, Soundblaster 512V sound card, 15" flat panel monitor, 3.5" floppy drive, Microsoft Natural keyboard Elite, Microsoft Mouse, Microsoft Windows 98 second edition update, and Microsoft Office Internet Explorer 5.0."*)]

a command-line interface; and

a menu-driven interface.

Regarding Claim 7:

Richards et al. teaches,

The system of claim 1 wherein the action plan further comprises a video component for heightening the user's motivation and sense of accomplishment. **[0047 ("*[0047] FIG. 10 shows an on-screen video or animation of a "talking head" virtual coach 35, an interactive coach and mentor who guides the user through choices and decision points at various levels and points in the exercise. The "talking head" virtual coach 35 can ask the user questions, via pre-recorded audio files or through intelligent voice synthesis methods, prompted by previous user inputs, that cause the user to reflect on the responses they give to different questions. Suitable speech synthesis programs are commercially available, such as Lucent Technologies' Text-to-Speech engine. The "talking head" virtual coach 35 can prompt the user to validate responses they have given or provide "what-if" scenarios, such as those relating to seemingly conflicting responses or proposed actions for improvements. The "talking head" coach 35 can welcome the user to the tool at the start of the program, explain to the user how the system works, and summarize areas for improvement and define action plans before the user exits from the software program.")]*

Regarding Claim 8:

Richards et al. teaches,

The system of claim 1 wherein the action plan is downloaded to a destination selected by the user. **[0028 & 0029 ("***0028] A particular embodiment of the present invention is concerned with adapting and improving known techniques to provide a powerful, engaging and valuable infotainment tool, i.e. it creates both valuable information and is entertaining at the same time, for both workplace and home use. It aims to extract key information relating to the myriad of*

*human and social issues and characteristics that contribute to an individual's social and professional networking capability. **Once these elements have been identified, they can be used to construct a plan of action against which the user can re-position their working or personal objectives.*** [0029] A typical embodiment of the invention is an interactive, internet based tool for constructing a user's network of contacts in the workplace. **The user accesses the tool by using browser software such as Microsoft Internet Explorer or Netscape Navigator on a personal computer (PC), Macintosh.TM., or network PC and enters the uniform resource locator (URL) for a specific website.** From this website, the user can **download** the tool in either high quality graphics form or low quality graphics form, **depending on the capability of the user's internet access (primarily determined by modem speed and line bandwidth) and system hardware.**")]*

Regarding Claim 9:

Richards et al. teaches,

The system of claim 8 wherein the destination is selected from a group comprising a Palm Inc. Palm ™ handheld, a personal digital assistant (PDA), an ACT!™ data store, an Outlook ® data store, a personal information manager (PIM) data store, and a world-wide-web-based internet data store. **[0030** ("*[0030] On beginning a downloaded software program or software loaded from source media such as a CD-ROM, DVD, Zip.TM. disc or floppy disc that executes a networking exercise on a system such as a computer (PC, Macintosh.TM., network PC or other machine capable of running and displaying applications software programs), a user completes a registration process in which personal details are entered and the user is then presented with a*

series of instructions and objects. The data relating to personal details and all other user-defined

data are stored in software-defined data files, either on a hardware system's (PC,

Macintosh.TM., network PC etc) hard drive or on a removable media drive (floppy disc, Zip.TM.

disc, magnetic tape or re-writeable CD-ROM for example), the data destination being definable

by the user. An example system that would enable the software program to operate effectively

would be a PC with a high speed processor (for example 600 MHz Intel Pentium.TM. III with

MMX technology and 512K cache), 13 Gb Ultra ATA hard drive (5400 rpm), 8.times. DVD-

ROM, 256 Mb SDRAM, 32 Mb Diamond Viper V770D AGP Graphics Card, Soundblaster 512V

sound card, 15" flat panel monitor, 3.5" floppy drive, Microsoft Natural keyboard Elite,

Microsoft Mouse, Microsoft Windows 98 second edition update, and Microsoft Office Internet

Explorer 5.0.")]

Regarding Claim 10:

Richards et al. teaches,

The system of claim 1 wherein the action plan is displayed on a display device selected from a

group comprising a computer monitor, a portable computer display, a personal digital assistant

display, a CRT, an LCD, a plotter, and a printer. **[0030** (*"[0030] On beginning a downloaded*

software program or software loaded from source media such as a CD-ROM, DVD, Zip.TM. disc

or floppy disc that executes a networking exercise on a system such as a computer (PC,

Macintosh.TM., network PC or other machine capable of running and displaying applications

software programs), a user completes a registration process in which personal details are

entered and the user is then presented with a series of instructions and objects. The data relating

*to personal details and all other user-defined data are stored in software-defined data files,
either on a hardware system's (PC, Macintosh.TM., network PC etc) hard drive or on a
removable media drive (floppy disc, Zip.TM. disc, magnetic tape or re-writeable CD-ROM for
example), the data destination being definable by the user. An example system that would enable
the software program to operate effectively would be a PC with a high speed processor (for
example 600 MHz Intel Pentium.TM. III with MMX technology and 512K cache), 13 Gb Ultra
ATA hard drive (5400 rpm), 8.times. DVD-ROM, 256 Mb SDRAM, 32 Mb Diamond Viper
V770D AGP Graphics Card, Soundblaster 512V sound card, 15" flat panel monitor, 3.5" floppy
drive, Microsoft Natural keyboard Elite, Microsoft Mouse, Microsoft Windows 98 second edition
update, and Microsoft Office Internet Explorer 5.0.")]*

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
> 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
> subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill
> in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

14.   **Claims 4-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Richards et al. (UNPAP Pub. No. 2002/-145626 A1), Filed Feb. 9, 2001;

Pub Date: Oct 10, 2002,

in view of

Ferstenberg et al. (USPN 5,873,071), Filed: May 15, 1997; Date of Patent: Feb. 16, 1999.

The *Richards et al.* reference has been discussed above and not explicitrly teach the limitation

in claim 4. However. *Ferstenberg et al.* teaches, the limitation of claim 4.

Regarding Claim 4:

Ferstenberg et al. teaches,

The system of claim 2 wherein the user input further comprises:

a list of how to affect the influence factors;

a statement of how to reduce the risk associated with the affecting influence; **[col. 24, line 41-54**

(*"According to a simple strategy called "list completion" (also called herein "list"), the*

participant merely instructs its e-agent to make exchanges from a list of commodities up to

certain maximum exchange amounts. Such a participant may optionally, specify limited types of

constraints, such as dollar imbalance or tiering constraints. According to a complex strategy

called "active with risk", the participant generally instructs its e-agent to substantially maximize

preferences or expected return while substantially minimizing risks associated with these

preferences. Optionally, the participant can specify broader types of additional constraints, such

as constraints on transaction costs of the exchange, on the deviation of the resulting portfolio

from specified allocation constraints, and so forth.")] It would have been obvious at the time the

invention was made to a person having ordinary skill in the art to because the risk represents the

participant's estimation of the uncertainties associated with owning a particular commodity, and

can be, e.g., the variance of the expected financial return from owning a commodity. The

transaction costs are estimates of the cost of buying or selling in a market, whereby a participant

can establish certain approximate goals for owning groups of commodities, and can afford a certain amount of repose juxtaposed the influence afforded ascertaining these goals.

and the weight of acting to reduce said risk.

Regarding Claim 5:

Ferstenberg et al. teaches,

The system of claim 1 wherein the action plan comprises:

weighted [(**col. 34, line 01-23** "*In certain situations, the preferred fairness measure, which weights equally all e-agents, fails to result in an allocation satisfactory to the objectives of all the participants. For example, certain participants who have specified large exchange amounts, can receive proportionately less than they feel is fair in cases where other participants have specified certain constraints, such as dollar imbalance constraints. In such situations, an alternative fairness measure incorporates fairness weights, delta..sup.b.sub.i and .delta..sup.s.sub.i, which can give certain e-agents a greater or lesser influence in the fairness measure for purchases or sales according to whether their weights are specified to be greater or less than 1, respectively. An exemplary weighted fairness measure is given by equation 25. ##EQU5## These fairness weights can be adjusted either during the course of an intermediated exchange or from one intermediated exchange to another, in order to satisfy the joint fairness requirements of all the participants.* ")] and *Ferstenberg et al.* does not teach, prioritized influence factors. However, *Richards et al.* teaches, prioritized influence factors; [0062

("*[0062] FIG. 20 provides an example of a flowchart of the logic for an Analysis mode. By way*

of example, in the analytical mode, the user begins by defining their role and the objectives that

they are trying to achieve, creates a series of network contacts by placing them in the

appropriate positions on the screen, and then allocates objectives for each network contact.

Connections are created between the user sphere and the network contact spheres and each

network contact has a series of attributes defined that specifies, for example, their respective

Power, Knowledge, Trust, Voice, Sharing and other relationship currencies. On completion of

the attributes, the user selects an Analysis option from, for example, the toolbar in a Microsoft

Windows.TM. graphic user interface environment. **The system then provides the user with an**

analysis of key issues arising from any conflicts between objectives, styles and preferences and

prepares, for example, prioritized issues and recommendations. *In another embodiment,*

"talking head" virtual coach 35 may be invoked to coach the user through the analysis. The

output of the analysis may be printed in hard copy and the user may then refine the attribute data

for specific network contacts to align with the recommendations provided by the analysis. An

action plan may then be created by the system for implementation by the user. The system

automatically saves any user inputs and modifications on user exit from the system. ")] It would

have been obvious at the time the invention was made to a person having ordinary skill in the art

to because the risk represents the participant's estimation of the uncertainties associated with

owning a particular commodity, and can be, e.g., the variance of the expected financial return

from owning a commodity. The transaction costs are estimates of the cost of buying or selling in

a market, whereby a participant can establish certain approximate goals for owning groups of

commodities, and can afford a certain amount of repose juxtaposed the influence afforded

ascertaining these goals.

and the weight of acting to reduce said risk.

weighted and prioritized affecting influences;

risk-weighted and willingness-weighted affecting influences; and

prioritized risk reduction actions and weights.

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16.   **Claims 11-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Richards et al. (UNPAP Pub. No. 2002/-145626 A1), Filed Feb. 9, 2001;

Pub Date: Oct 10, 2002,

in view of

Ferstenberg et al. (USPN 5,873,071), Filed: May 15, 1997; Date of Patent: Feb. 16, 1999.

Regarding Claim 11:

Richards et al. teaches,

A computer-implemented method for personal development training comprising the steps of:

obtaining user input comprising the user's vision and goal, possible outcomes, influencing,

factors on the possible outcomes and relevant data for each of the influence factors; **[0031;** (*"On*

accessing the web site, the user may locate the tool access button on the first web page and click

on the button to download the first part of the tool. In this embodiment, **as the user completes**

registration information (such as, but not limited to, personal details, professional qualifica-

tions, goals, objectives) *downloads of necessary software may be completed in parallel. In this*

embodiment, the user may be greeted by a 3-dimensional graphic user interface and an animated

"talking head" virtual coach who helps the user to input information. **User specific information**

may be supplied through user text entry, multiple choice from drop-down menus, responses to

audio clips and videos, user-positioning of objects on the screen, and role-playing in on-screen

animations.")] **& [0033** (**"*The data acquisition phase may continue with the definition of the*

types of currency traded between the user and network contacts. In this context, currency

refers to characteristics of the relationship such as the level of mutuality and reciprocity of the

relationship, the predictability of the relationship, the level of trust and the ability for each

individual to express them- selves. Some of the questions posed may be repeated within

different phrasings to validate the responses. *In one embodiment, the data acquisition phase*

may allow users to complete specific network connections in their entirety or allow desired

network connections to be assessed according to a specific question category, for example, trust

or mutuality or predictability.")]

generating and displaying an action plan to the user based on the user input. **[(0028** *"Once these*

elements have been identified, they can be used to **construct a plan of action** *against which the*

user can re-position their working or personal objectives.")] & [FIG. 20: Analysis Flowchart;

Process box: "Action Plan defined by system")]

Richards et al. does not explicitly teach, for each influence factor, reducing a risk associated with

the influence factor to art acceptable level if the risk is too high relative to the importance of the

influence factor. However, *Ferstenberg et al.* teaches, for each influence factor, reducing a risk

associated with the influence factor to art acceptable level if the risk is too high relative to the

importance of the influence factor. **[col. 24, line 41-66** (*"According to a simple strategy called*

"list completion" (also called herein "list"), the participant merely instructs its e-agent to make

exchanges from a list of commodities up to certain maximum exchange amounts. Such a

participant may optionally, specify limited types of constraints, such as dollar imbalance or

*tiering constraints. According to a complex strategy called "**active with risk**", the participant*

generally instructs its e-agent to substantially maximize preferences or expected return while

*substantially **minimizing risks** associated with these preferences. Optionally, the participant can*

specify broader types of additional constraints, such as constraints on transaction costs of the

exchange, on the deviation of the resulting portfolio from specified allocation constraints, and so

*forth. A less complex strategy is called "**active with no risk**," and differs from the "**active with***

***risk**" strategy only in that **risk is not considered by the e-agent**, which substantially maximizes*

only expected returns subject to optional constraints. According to the "indexing" strategy a

*participant instructs its e-agent to substantially **minimize the risk**, or variance of the return, of a*

portfolio that represents the difference between the participant's current portfolio and a

benchmark portfolio, such as the S&P 500. A participant using "characteristics strategy," for

example, may instruct its e-agent to invest up to $100M with 40% in identified technology stocks,

40% in automobile stocks, and 20% in banking stocks.")] It would have been obvious at the time

the invention was made to a person having ordinary skill in the art to because the risk represents

the participant's estimation of the uncertainties associated with owning a particular commodity,

and can be, e.g., the variance of the expected financial return from owning a commodity. The

transaction costs are estimates of the cost of buying or selling in a market, whereby a participant

can establish certain approximate goals for owning groups of commodities, and can afford a cer-

tain amount of repose juxtaposed the influence afforded ascertaining these goals.

Regarding Claim 12:

Richards et al. teaches,

The method of claim 11, wherein the step of obtaining the relevant data for each of the influence

factors further comprises:

obtaining the effect of the influence factors on the possible outcome; **[0034 (***"[0034] When the \
data acquisition phase is completed, the user receives a 3-dimensional display of the relationship
of each network contact to themselves and of each network contact to each other. The user may
rotate the graphics displayed on the screen about a central axis so as to gain alternative views of
the network relationships.* **Each network contact occupies a space that is defined according to
responses provided during the data acquisition phase. These may be spaces such as, but not
limited to, the knowledge space, the emotional space, or the development space (referred to
herein as "NetSpaces"). These "NetSpaces" together form the 3-dimensional environment in
which each network contacts' sphere is placed.***")]**

obtaining the weight of the influence factor on the possible outcome;

obtaining a statement about what drives the influence factor;

obtaining the timeframe under which the influence factor operates;

obtaining an affecting influence statement about how to affect the influence factor;

obtaining the weight of affecting the influence factor;

obtaining the risk of affecting the influence factor; and

obtaining the willingness to take said risk.

Regarding Claim 13:

Ferstenberg et al. teaches,

The method of claim 11 wherein the step of risk reduction comprises:

comparing the influence factor's risk to the influence factor's importance;

displaying a list of how to affect the influence factors;

obtaining a statement of how to reduce the risk associated with the affecting influence; **[col. 24,**

line 41-66 ("*According to a simple strategy called "list completion" (also called herein "list"),*

the participant merely instructs its e-agent to make exchanges from a list of commodities up to

certain maximum exchange amounts. Such a participant may optionally, specify limited types of

constraints, such as dollar imbalance or tiering constraints. According to a complex strategy

called "active with risk", the participant generally instructs its e-agent to substantially maximize

preferences or expected return while substantially minimizing risks associated with these

preferences. Optionally, the participant can specify broader types of additional constraints, such

as constraints on transaction costs of the exchange, on the deviation of the resulting portfolio

*from specified allocation constraints, and so forth. A less complex strategy is called "**active with***

no risk**," and differs from the "**active with risk**" strategy only in that **risk is not considered by

***the e-agent**, which substantially maximizes only expected returns subject to optional constraints.*

*According to the "indexing" strategy a participant instructs its e-agent to substantially **minimize***

***the risk**, or variance of the return, of a portfolio that represents the difference between the*

participant's current portfolio and a benchmark portfolio, such as the S&P 500. A participant

using "characteristics strategy," for example, may instruct its e-agent to invest up to $100M with

40% in identified technology stocks, 40% in automobile stocks, and 20% in banking stocks.")]

and

obtaining the weight of acting to reduce said risk.

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18.   **Claims 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Richards et al. (UNPAP Pub. No. 2002/-145626 A1), Filed Feb. 9, 2001;

Pub Date: Oct 10, 2002,

in view of

Ferstenberg et al. (USPN 5,873,071), Filed: May 15, 1997; Date of Patent: Feb. 16, 1999.

Regarding Claim 14:

Richards et al. teaches,

A computer program product comprising a computer useable medium having computer program

instructions stored therein for generating an action plan based on user Input, the computer

program product comprising instructions for:

obtaining user input comprising the user's vision and goal, possible outcomes, influencing factors

on the possible outcomes and relevant data for each of the influence factors; **[0031; (***"On*

accessing the web site, the user may locate the tool access button on the first web page and click

on the button to download the first part of the tool. In this embodiment, **as the user completes**

registration information (such as, but not limited to, personal details, professional qualifica-

tions, goals, objectives) *downloads of necessary software may be completed in parallel. In this*

embodiment, the user may be greeted by a 3-dimensional graphic user interface and an animated

"talking head" virtual coach who helps the user to input information. **User specific information**

may be supplied through user text entry, multiple choice from drop-down menus, responses to

audio clips and videos, user-positioning of objects on the screen, and role-playing in on-screen

animations.*"***)]** & **[0033 (***"The data acquisition phase may continue with the definition of the*

types of currency traded between the user and network contacts. In this context, currency

refers to characteristics of the relationship such as the level of mutuality and reciprocity of the

relationship, the predictability of the relationship, the level of trust and the ability for each

individual to express them- selves. Some of the questions posed may be repeated within

different phrasings to validate the responses. In one embodiment, the data acquisition phase

may allow users to complete specific network connections in their entirety or allow desired

network connections to be assessed according to a specific question category, for example, trust

or mutuality or predictability.")]

generating and displaying an action plan to the user based on the user input. [(0028 *"Once these*

*elements have been identified, they can be used to **construct a plan of action** against which the*

user can re-position their working or personal objectives.")]

Richards et al. does not explicitly teach, for each influence factor, reducing a risk associated with

the influence factor to art acceptable level if the risk is too high relative to the importance of the

influence factor. However, *Ferstenberg et al.* teaches, for each influence factor, reducing a risk

associated with the influence factor to art acceptable level if the risk is too high relative to the

importance of the influence factor. [**col. 24, line 41-66** (*"According to a simple strategy called*

"list completion" (also called herein "list"), the participant merely instructs its e-agent to make

exchanges from a list of commodities up to certain maximum exchange amounts. Such a

participant may optionally, specify limited types of constraints, such as dollar imbalance or

*tiering constraints. According to a complex strategy called **"active with risk"**, the participant*

generally instructs its e-agent to substantially maximize preferences or expected return while

*substantially **minimizing risks** associated with these preferences. Optionally, the participant can*

specify broader types of additional constraints, such as constraints on transaction costs of the

exchange, on the deviation of the resulting portfolio from specified allocation constraints, and so

*forth. A less complex strategy is called **"active with no risk,"** and differs from the **"active with***

***risk"** strategy only in that **risk is not considered by the e-agent**, which substantially maximizes*

only expected returns subject to optional constraints. According to the "indexing" strategy a

participant instructs its e-agent to substantially minimize the risk, or variance of the return, of a

portfolio that represents the difference between the participant's current portfolio and a

benchmark portfolio, such as the S&P 500. A participant using "characteristics strategy," for

example, may instruct its e-agent to invest up to $100M with 40% in identified technology stocks,

40% in automobile stocks, and 20% in banking stocks.")] It would have been obvious at the time

the invention was made to a person having ordinary skill in the art to because the risk represents

the participant's estimation of the uncertainties associated with owning a particular commodity,

and can be, e.g., the variance of the expected financial return from owning a commodity. The

transaction costs are estimates of the cost of buying or selling in a market, whereby a participant

can establish certain approximate goals for owning groups of commodities, and can afford a cer-

tain amount of repose juxtaposed the influence afforded ascertaining these goals.

Conclusion

19.   The prior art made of record and (listed of form **PTO-892**) not relied upon is considered

pertinent to applicant's disclosure as follows. Applicant or applicant's representative is respect-

fully reminded that in process of patent prosecution i.e., amending of claims in response to a

rejection of claims set forth by the Examiner per Title 35 U.S.C. The patentable novelty must be

clearly shown in view of the state of the art disclosed by the references cited and any objections

made. Moreover, applicant or applicant's representative must clearly show how the amendments

avoid or overcome such references and objections. *See* **37 CFR § 1.111(c)**.

Correspondence Information

20.   Any inquiries concerning this communication or earlier communications from the examiner should be directed to **Michael B. Holmes** who may be reached via telephone at **(703) 308-6280**. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding After Final issues, please send it to **(703) 746-7238**. If you need to send an Official facsimile transmission, please send it to **(703) 746-7239**. If you would like to send a Non-Official (draft) facsimile transmission the fax is **(703) 746-7240**. If attempts to reach the examiner by telephone are unsuccessful, the **Examiner's Supervisor, Anil Khatri**, may be reached at **(703) 305-0282**.

Any response to this office action should be mailed too:

Director of Patents and Trademarks Washington, D.C. 20231. Hand-delivered responses should be delivered to the Receptionist, located on the fourth floor of **Crystal Park II, 2121 Crystal Drive Arlington, Virginia.**

Michael B. Holmes
Patent Examiner
Artificial Intelligence
Art Unit 2121

United States Department of Commerce
Patent & Trademark Office